



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/980,917	02/20/2002	Frank Becher	R00360US (#90568)	3850

28672 7590 05/28/2003

D. PETER HOCHBERG CO. L.P.A.  
1940 EAST 6TH STREET  
CLEVELAND, OH 44114

EXAMINER

PHAM, HAI CHI

ART UNIT

PAPER NUMBER

2861

DATE MAILED: 05/28/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/980,917

Applicant(s)

BECHER, FRANK

Examiner

Hai C Pham

Art Unit

2861

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 13-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 13-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4,7. 6) ☐ Other:

## DETAILED ACTION

### *Priority*

1. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). A copy of the certified copy of the priority document has been received in this National Stage application from the International Bureau. **Specification**
2. The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

### Arrangement of the Specification

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.
- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
- (d) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC (See 37 CFR 1.52(e)(5) and MPEP 608.05. Computer program listings (37 CFR 1.96(c)), "Sequence Listings" (37 CFR 1.821(c)), and tables having more than 50 pages of text are permitted to be submitted on compact discs.) or  
REFERENCE TO A "MICROFICHE APPENDIX" (See MPEP § 608.05(a). "Microfiche Appendices" were accepted by the Office until March 1, 2001.)
- (e) BACKGROUND OF THE INVENTION.
  - (1) Field of the Invention.
  - (2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.
- (f) BRIEF SUMMARY OF THE INVENTION.
- (g) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).
- (h) DETAILED DESCRIPTION OF THE INVENTION.
- (i) CLAIM OR CLAIMS (commencing on a separate sheet).
- (j) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).
- (k) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A "Sequence Listing" is required on paper if the application discloses a

nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required "Sequence Listing" is not submitted as an electronic document on compact disc).

### ***Claim Objections***

3. Claims 14 and 19 are objected to because of the following informalities:

Claim 14:

- "-is" should read --is--.

Claim 19:

- "while applying the laser-exposed characters" at line 5 should read --while forming the laser-exposed character--.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 13-28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 13:

- The limitation "placing the adhesive in a support position" appears to be misleading in that the adhesive [layer] is an integral part of the sheet-like adhesive system, inseparable from the other layers. The above limitation should

read --placing the sheet-like adhesive system with the adhesive side facing a support position--.

Claim 18:

- The limitation "inscribing the laser-exposed information in the form of characters or signs onto the underlying layer to be inscribed" (emphasis added) appears to be misleading in that the characters are instead formed onto the overlying layer by exposure of the laser, and that the laser-exposed characters are visualized on the background of the underlying material layer (see specification on page 6, first paragraph).

Claim 24:

- The limitation "data generated by other production steps" (emphasis added) is unclear in that it is not known whether the other production steps are part of the claimed process for inscription, and that it is unclear how such production steps are conducted.

Claim 26:

- The limitation "means for the control of the laser beam" (emphasis added) renders the claim indefinite because the element or step is not defined in the specification by corresponding structure, material or acts.

Claim 27:

- The limitation "data generated by other production steps" (emphasis added) is unclear in that it is not known whether the other production steps are part of the

claimed process for inscription, and that it is unclear how such production steps are conducted.

Claim 28:

- The limitation "means for the control of the laser beam" (emphasis added) renders the claim indefinite because the element or step is not defined in the specification by corresponding structure, material or acts.

Claims 14-17, 19-23, 25 are dependent from claims 13 above, and are therefore indefinite.

Appropriate correction is required.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 13-21, and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's Acknowledged Prior Art (hereinafter AAPA) in view of <sup>Clement et al.</sup> Caporaletti et al. (EP 0 987 121 A2). (WO 97/44196)

AAPA discloses a well known practice in the art to imprint and mark adhesive system using a movably guided laser beam, the adhesive system including at least one ingredient containing layer, a material layer to be inscribed, an information layer

HP  
6/17/03

Art Unit: 2861

overlying said material layer to be inscribed and a backing layer impermeable to ingredients or water vapor, the process of inscribing comprising exposing the adhesive system from the information overlying side based on a programmable control unit.

However, AAPA fails to teach the control of the intensity and penetration depth of the laser beam according to the material properties of the system in such a way that the laser beam does not penetrate far enough to reach one of the at least one ingredient-containing layer and preventing a detrimental influence on the ingredients contained in the system, and the overlying layer being a color layer, which disintegrates at a moderate laser irradiation level, the overlying layer having a conspicuous color relative to the layer to be inscribed, applying at least two overlying pigmented layers to the layer to be inscribed, and further including disintegrating the at least two pigmented layers by accurate control of the penetration depth of the laser beam to visualize the at least two underlying pigmented color layers.

Nevertheless, Clement et al. discloses a method for forming visible images by laser radiation with the energy as well as the depth or penetration of the laser beam being carefully programmed and/or adjusted such that only selective overlying layers are ablated at the depth of the selected layer without affecting further layers, the overlying layers being colored layers so as to selectively reveal different layers, the ablation of the specific layer including the uppermost overlying layer of the two top overlying layers.

It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the AAPA's device with the aforementioned teaching of

Clement et al. The motivation for doing so would have been to allow the laser beam to penetrate to a specific depth to expose the required pigment.

With regard to claims 14-15, AAPA discloses the sheet-like adhesive system being an active agent-containing therapeutic system, and the active-agent containing therapeutic system being in the form of a plaster.

8. Claims 22-24 and 26-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over AAPA in view of Clement et al., as applied to claim 13 above, and further in view of Jack (U.S. 5,151,572).

AAPA, in view of Clement et al., discloses all the basic limitations of the claimed invention except for the programmable central control unit including a keyboard and accepting transferred data.

However, Jack discloses a method and apparatus for making a stencil for etching glass using a laser beam to cut through the thin stencil template from a label, the apparatus including a host computer with a user input device, e.g. keyboard, and a laser interface card such that the parameters of the laser beam are controlled based on a user interface control software stored in the host computer.

It would have been obvious at the time the invention was made to a person having ordinary skill in the art to incorporate the user interface control software as taught by Jack in the modified device of AAPA. The motivation for doing so would have been to provide a consistent, repeatable process of inscribing information on the label with preciseness.



***Contact information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hai C Pham whose telephone number is (703) 308-1281. The examiner can normally be reached on T-F (8:30-5:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Benjamin R. Fuller can be reached on (703) 308-0079. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7722, (703) 308-7724, (703) 308-7382, (703) 305-3431, (703) 305-3432 for regular communications and for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.



HAI PHAM  
PRIMARY EXAMINER

May 15, 2003